

Appl. No. 10/538,165
Amdt. Dated March 2, 2010
Reply to Office Action of November 5, 2009

Attorney Docket No. 81887.0124
Customer No. 26021

REMARKS/ARGUMENTS

Claims 3, 4, 7, and 8 are pending in the application. Claims 1, 2, 5, 6, 9, and 10 are canceled without prejudice. Reexamination and reconsideration of the application are respectfully requested.

Changes are made to the specification. Support for the changes is discussed herein.

INTERVIEW SUMMARY

On February 18, 2010, Patent Agent Barry Shuman conducted a telephone interview with Examiner Marivelisse Santiago-Cordero and the Examiner's Supervisor Vincent P. Harper. During the interview the parties discussed the Office Action dated November 5, 2009. Specifically, what the Office referred to as Applicant's Admitted Prior Art was discussed. No agreement was reached during the interview.

Applicant would like to thank Examiner Marivelisse Santiago-Cordero and the Examiner's Supervisor Vincent P. Harper for the courtesy of granting a telephone interview with Patent Agent Barry Shuman.

SPECIFICATION OBJECTION

The Action objects to the specification amendment submitted in the previous response. In particular, the Action objects to figure description "Figs. 3A to 3C are timing charts showing processing performed in the 1xEVDO only system during a conventional suspend time" because, according to the Action, the qualifier "only" raises new matter issue.

Applicant disagrees with the position taken by the Action. However, to advance the prosecution of present application, applicant amends the objected

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figure description to its previous form. There being no reason for the objection remaining, the specification objection should be withdrawn.

DRAWING OBJECTION

The Action objects to FIG. 3C because, according to the Action, FIG. 3C is prior art. And the label "prior art" must be affixed to the figure.

Applicant disagrees with the position taken by the Action, and maintains applicant's position that FIG. 3C is not prior art to the present application. In the section discussing the § 103 rejection below, applicant sets forth irrefutable supports showing that FIG. 3C is not prior art.

Because FIG. 3C is not prior art, the objection to that figure should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C § 103

Claims 3, 4, 7, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over FIG. 3C and FIG. 4 of applicant's specification. Applicant respectfully submits that the combination suggested by the office cannot render claims 3, 4, 7 and 8 unpatentable because FIG. 3C is not prior art. Moreover, even assuming the FIG. 3C is prior art, FIG. 3C and FIG. 4 do not render obvious the claims of present invention. Accordingly. Applicant traverses the § 103 (a) rejections over claim 3.

Claims 3 recites:

A wireless communication terminal, which performs wireless communication using each of a first communication protocol and a second communication protocol and enables to be in an idle state with both protocols, comprising:

a setting section that sets a suspend time for detecting an incoming call from a base station using the first communication protocol subsequent to completion of communication with the base station using the first communication protocol;

a first changing section that changes a monitoring timing of the second communication protocol; and

a second changing section that changes a monitoring timing of the first communication protocol by communicating with the base station when the first changing section changes the monitoring timing of the second communication protocol,

wherein the setting section does not set the suspend time after the second changing section changes the monitoring timing of the first communication protocol by communicating with the base station.

The Action argued the FIG. 3C is prior art, and found that the combination of FIG. 3C and FIG. 4 obviate claim 1. Because FIG. 3C is not prior art, and every if it is, such finding of obviousness is contrary to the holdings of the Supreme Court, applicant traverses.

Applicant's specification makes it clear that FIG. 3C is not prior art. The only portion of the specification relied upon by the office is the brief description of FIGS. 3A-3C at page 7, lines 16-18, which states,

"Figs. 3A to 3C are timing charts showing processing performed in the 1xEVDO system during a **conventional suspend time**" (Emphasis added by applicant).

This description simply does not support the Action's assertion that FIG. 3C is prior art. Importantly, the reference to "a conventional suspend time" in the brief description is **singular** not plural. The description clearly states FIG. 3A-C illustrate **ONE and only ONE** conventional suspend time., which the specification

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makes clear, and those of ordinary skill in the art would understand, are FIGS. 3A and 3B.

At best, the brief description cited by the office, by itself, is ambiguous as to whether FIG. 3C is "a conventional suspend time." However, the remainder of the specification (1) makes clear that FIG. 3C is not admitted prior art, and (2) is consistent with the position that FIGS. 3A and 3B illustrate the prior art system. In the background section, applicant's specification at page 3, lines 4-14 states,

"Incidentally, in the 1xEVDO system, the wireless communication terminal awaits in a measurement status where an incoming signal output from the base station can be received during a certain period of time after completion of communication processing with the base station, in consideration of occurrence of disconnection due to instantaneous interruption of a radio wave during communication.

For this reason, the antenna and the radio section are occupied by the 1xEVDO system for a certain period of time after termination of communication."

The cited section of applicant's specification clearly indicates that the prior art 1xEVDO system has a non-zero suspend time ("during a certain period of time...").

Moreover, applicant's specification at page 17, last paragraph states,

"The wireless communication terminal of the present embodiment of the invention is configured such that, in order to solve the problem, the suspend time of the 1xEVDO system is set as the related art in the event of unexpected termination of communication such as instantaneous interruption of a radio wave during data communication of the 1xEVDO system; and

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such that the suspend time is not set when the processing for communication with the base station has ended properly.”

The cited section of applicant's specification clearly states that that the “related art” 1xEVDO system has a set (non-zero) suspend time and that only in the present invention is the suspend time not set.

Furthermore, applicant's specification at page 14, lines 11-12 states,

“Fig. 3C is a timing chart of a case where a suspend time is not set (specifically, Suspend Time = 0).”

Thus, contrary to the Office's assertion, that the conventional suspend time refers to the situation of FIGS. 3A and 3B, and FIG. 3C is not prior art. Thus, the § 103(a) rejections, which are based on the proposition that FIG. 3C is prior art, should be withdrawn.

Even assuming *arguendo* that FIG. 3 of applicant's specification constitutes prior art (AAPR), the cited art still does not render the claims obvious. The Action argues that FIG. 3C teaches a 1xEVDO device that does not set a suspend time, which would results in reduced power consumption. Citing the power reduction as the motivation, the Action further argues that the combination of FIG. 3C and FIG. 4 obviated claim 3 of present application.

Applicant respectfully asserts that the claimed invention is not obvious in over the cited art in view of United States v. Adams, 86 S. Ct. 708, 713 (1966) and KSR Int'l Co. v. Teleflex, Inc. 127 S. Ct. 1727 (2007). In Adams and KSR, Supreme Court noted that strong indicia of non-obviousness were: (1) the prior art teaches away from the claimed combination of elements and (2) the claimed combination of elements delivers unexpected results.

The Adams case is particularly illustrative. The patent at issue in Adams was directed at a wet battery having a magnesium anode and water electrolyte. At that time, batteries with zinc anodes were known, and the Government relied on

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the Wood reference and the Codd reference for its invalidity argument. Wood taught that a magnesium electrode would produce a high voltage cell, which was desirable. However, Wood also taught that magnesium was unsuitable for battery because magnesium was susceptible to corrosion (Adams at 711, 712). Codd also suggested that magnesium was a good candidate for anode, but also noted that a battery containing an acid would destroy the magnesium anode (Adams at 712). The government argued that Wood and Codd provide that magnesium anode was a suitable substitute for the known zinc anode because of its potential to deliver a battery with higher voltage potential.

The Court disagreed. Although the advantages of using a magnesium anode were known, the combination of elements including magnesium was not obvious. the Court took notice that (1) the known disadvantages of using the magnesium anode would dissuade its usage (Adams at 714, citing that water electrolyte used by Adams was “detrimental to the use of magnesium”), and (2) the claimed device “wholly unexpectedly” produced “certain valuable operating advantages over other batteries” (id.).

As with Adams, the claims of present application are patentable over the cited art. The Action argued that the FIG. 3C provided that the 1xEVDO entering a sleep mode with no set suspend time would save power. Ostensibly, the power-saving measure would be the motivation to combine the features FIG. 3C with the device of FIG. 4.

The Adams and KSR decision mandate the conclusion that the claim 1 is not obviated by FIG. 3C and FIG. 4. As in Adams, the “prior art” of instant case **teaches away** from the proposed combination. Applicant’s specification at page 14, line 24 states, in reference to FIG. 3C, “Specifically, when the suspend time is not set, a throughput of data communication is deteriorated when the state of the radio wave is not good.” Applicant’s specification thus makes clear that not setting the

suspend time was understood by those in the art to deteriorate data communication and thus was to be avoided. Since the primary purpose of a communication device is to enable communication, practitioners would not have been motivated to not set a suspend time. And the Office's stated motivation "conserving battery power" would not have motivated one of ordinary skill in light of the understanding of those skilled in the art that "when the suspend time is not set, a throughput of data communication is deteriorated when the state of the radio wave is not good."

Furthermore, as in Adams, the claimed invention produces unexpected and fruitful results contrary to the prior art's teaching. The inventors of the present invention discovered (among other things) that, in certain operations, not setting the suspend time would not impact the communication perform. This insight is not seen or foreseeable based on the disclosure of FIG. 3C. In particular, claim 3 recites a condition that the device switches to 1xEVDO when "the second changing section changes the monitoring timing of the first communication protocol by communicating with the base station." In that condition, the device may have a suspend time of zero (not setting the suspend time), and the communication performance would not deteriorate. In parallel, Adams' battery was stable, contrary to the prior art's assertion. As with the instant case, Adams discovered a product with unexpected and fruitful results via insights not seen in the prior art.

In view of Adams (and affirmed in KSR), applicant submits that claim 3 is not obviated by FIG. 3C and FIG. 4 of applicant's specification. Thus, the § 103(a) rejections of claim 3 and claim 3, which depends from claim 1, should be withdrawn.

Moreover, claim 7 recites similar limitations as claim 3 discussed above, including "changing a monitoring timing of the first communication protocol by communicating with a base station based on a change of a monitoring timing of the second communication protocol, and not setting a suspend time for detecting an incoming call from the base station using the first communication protocol after the

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monitoring time of the first communication protocol is changed by communicating with the base station.” Accordingly, the prior art cannot obviate claim 7 for the same reasons as claim 3 discussed above. The § 103(a) rejections of claim 7 and claim 8, which depends from claim 7, should therefore be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (310) 785-4600 to discuss the steps necessary for placing the application in condition for allowance.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,
HOGAN & HARTSON L.L.P.

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By: _____ /BMS/

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